

**REMARKS**

Applicants submit the following remarks in reply to the non-final Office Action mailed on May 2, 2006. By the present amendment, Applicants amend claims 1, 6, 8, 9, 12, 14, 16-19, 23, and 24, and add new claims 25-27, which do not introduce any prohibited new matter to this application. Upon entry of the present amendment, claims 1-27 will remain pending in the present application.

I. **Examiner's Objections to the Abstract and Specification**

In the Office Action of May 2, 2006, the Examiner objects to the Abstract for reciting "software means may be provided," and objects to the specification for containing certain trademark terminology.

In response to the Examiner's objections to the Abstract, Applicants do not understand the basis of this objection. On page 3 of the Office Action, the Examiner asserts: "The use of the verb 'may be' renders the claim[ed] invention indefinite because it is unclear whether or not the software means is included in the subject matter of the invention." However, the cited terminology is not used in the claims. The invention is defined in the claims, and not in the Abstract. Therefore, Applicants respectfully disagree with the Examiner's assertion that the use of the phrase "may be" in the Abstract renders the claims indefinite.

In response to the Examiner's objections to the specification for containing certain trademark terminology, Applicants hereby amend the specification to include appropriate trademark notation.

Accordingly, reconsideration and withdrawal of the objections is respectfully requested and believed appropriate.

II. Examiner's Objections to the Claims

On page 4 of the Office Action, the Examiner objects to claims 6 and 17 for including the term "debugging process." Applicants' amendments to the claims have rendered this objection moot.

III. Double Patenting Rejection

On pages 4-6 of the Office Action, the Examiner rejects claims 1-24 under the doctrine of provisional obviousness-type double patenting, as being unpatentable over claims 1-24 of co-pending U.S. Patent Application No. 10/611,860. Applicants' amendments to the claims have rendered this rejection moot.

IV. 35 U.S.C. § 101 Rejection

On pages 6-7 of the Office Action, the Examiner rejects claims 23-24 as being directed to non-statutory subject matter. Claims 23 and 24 have been amended, thereby rendering the rejections moot.

V. Claim Rejections Under 35 U.S.C. § 102(e)

On pages 8-11 of the Office Action, the Examiner rejects claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by Jonathan B. Rosenberg, How Debuggers Work, September 27, 1996, Wiley Computer Publishing ("Rosenberg"). Applicants respectfully traverse these rejections.

Rosenberg discloses a debugger software program that allows users to select individual breakpoints. Users may view a set of breakpoints and may individually modify each breakpoint. See Rosenberg, pp. 27-28. Breakpoints are set in a debugger program that places the breakpoints into an executable in a source view by specifying a source line in the source view. See id., pp. 22-25, 110-111. Some of these breakpoints may be associated with conditions that determine whether a user should be notified of an activated breakpoint. See id., p. 109.

Claim 1, however, recites, *inter alia*, “[a] method for debugging a first computer program code by using debugging software, the method comprising: including breakpoint computer program code within the first computer program code, the breakpoint computer program code referring to one or more conditional breakpoints.” Although Rosenberg describes that breakpoints may be conditional, Rosenberg does not disclose breakpoint computer program code included within the first computer program code (e.g., source code), the breakpoint computer program code referring to one or more conditional breakpoints. Rosenberg simply fails to discuss how conditional breakpoints are implemented. As such, Rosenberg fails to disclose each and every limitation of claim 1. Accordingly, Applicants request that the rejection of claim 1 under 35 U.S.C. § 102 be withdrawn and the claim allowed.

Claims 2-11 and 25 depend from claim 1, and are therefore allowable for at least the same reasons set forth with regard to claim 1.

VI. Claim Rejections Under 35 U.S.C. § 103(a)

On pages 11-15 of the Office Action, the Examiner rejects claims 12-24 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Applicants respectfully traverse these rejections. Independent claims 12 and 23, although different in scope from claim 1, are distinguishable from the cited art for reasons similar to those discussed in connection with claim 1. Accordingly, Applicants request that the rejection of claims 12 and 23 be withdrawn and the claims allowed. Claims 13-22 and 26 depend from claim 12 and claims 24 and 27 depend from claim 23, and are therefore allowable for at least the same reasons set forth with regard to claims 12 and 23.

VII. Conclusion

In view of the foregoing remarks, the pending claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of all of the claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office Action.

If a telephone interview will expedite issuance of this application, the Examiner is requested to call Applicants' representative, whose name and registration number appear below, to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 25, 2006

By: Bradley Edelman  
Bradley Edelman  
Reg. No. 57,648